



UNITED STATES DEPARTMENT OF COMMERCE  
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

08/855,387 05/13/97 CHILTON

H 3747-021

IM31/0820

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EXAMINER

HRUSKOCIC, P

ART UNIT

PAPER NUMBER

1724 *C*

**DATE MAILED:**

08/20/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

|                                      |                                       |
|--------------------------------------|---------------------------------------|
| Application No.<br><b>08/855,387</b> | Applicant(s)<br><b>Chilton et al.</b> |
| Examiner<br><b>Hruskoci</b>          | Group Art Unit<br><b>1724</b>         |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

Responsive to communication(s) filed on 7-16-98.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

### Disposition of Claims

Claim(s) 1 - 21 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-21 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on 7-16-98 is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of References Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other \_\_\_\_\_

## Office Action Summary

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chilton et al. in view of Stoyell et al.. Chilton et al. disclose (see col. 2 line 44 through col. 5 line 60) a fuel filter assembly substantially as claimed. The claims differ from Chilton et al. by reciting the assembly includes an outer layer of extruded mesh. Stoyell et al. disclose (see col. 5 line 44 through col. 7 line 60, and col. 18 line 54 through col. 20 line 41) that it is known in the art to utilize an outer layer of extruded mesh to improve distribution of fluid along the surface of a filter medium. It would have been obvious to one skilled in the art to modify the assembly of Chilton et al. by including an outer layer extruded mesh in view of the teachings of Stoyell et al., to improve distribution of fuel along the surface of the filter assembly. The specific types of filaments and bonds used to form the extruded mesh would have been an obvious matter of engineering design to one skilled in the art, depending on the specific fuel treated and results desired, absent a sufficient showing of unexpected results.

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3. Applicants argue that Chilton et al. is commonly owned by the same assignee and is not considered prior art under 35 USC 102 (b). It is submitted that Chilton et al. has a different inventive entity from the instant application and qualifies as prior art under 35 USC 102 (e). It is further submitted that the above rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the patent was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

4. Applicants arguments concerning Stoyell et al. are based on the propriety of Chilton et al., which is deemed properly applied for reasons stated above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is (703) 308-3839. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jay Woo, can be reached on (703) 308-3793. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



Peter A. Hruskoci  
Primary Examiner  
Art Unit 1724

P. Hruskoci  
August 19, 1998